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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,708	04/05/2001	Rabindranath Dutta	AUS9-2001-0048-US1	3963

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IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT
11400 BURNET ROAD
AUSTIN, TX 78758

EXAMINER

CHOU DHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,708

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Azizul Choudhury

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/5/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This office action is in response to the correspondence received on November 15, 2004.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Skladman et al (US Pat No: US006400810B1) in view of Lee et al (US Pat No: US006212553B1), hereafter referred to as Skladman and Lee, respectively.

1. With regards to claims 1, 13 and 20, Skladman teaches through Lee, a method for sending electronic mail (e-mail), from a sender to a plurality of recipients, comprising: receiving input from said sender specifying said recipients of an e-mail message; and for each of said recipients, receiving input from said sender to create a tag indicating the importance of said e-mail message, wherein said tags may vary from one of said recipients to another

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). In addition, Skladman's design features a central storage location for the recipient's preferences (notification server) enabling

the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman) hence claimed traits such as the sender specifying recipients are present within Skladman's design. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

2. With regards to claims 2, 14 and 21, Skladman teaches through Lee, the method further comprising: providing a plurality of said tags with predefined content

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). The user is able to select the notification from predefined options. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

3. With regards to claims 3, 6, 15 and 22, Skladman teaches through Lee, the method further comprising: automatically providing default tags, in the absence of contrary input from said sender, wherein said default tags may vary according to the status of said recipients

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). The user is able to select the notification from predefined options. Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). The automatic providing of default tags is a regular email feature. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

4. With regards to claims 4, 16 and 23, Skladman teaches through Lee, the method wherein said sender can compose the content of said tags

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications (equivalent to the claimed compose trait) and flags (tags) based on sender (column 3, lines 4-61 Skladman). However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

5. With regards to claim 5, Skladman teaches through Lee a method for sending e-mail, from a sender to a plurality of recipients, comprising: providing tags, to convey information about the importance of an e-mail message; receiving input from said sender specifying said recipients of said e-mail message; and for each of said recipients, receiving input from said sender specifying one of said tags to be placed on said e-mail message, wherein said tags may vary from one of said recipients to another

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). In addition, Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman) hence claimed traits such as the sender specifying recipients are present within Skladman's design. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

6. With regards to claim 7, Skladman teaches through Lee a method for providing e-mail services, said method comprising: receiving input from a sender specifying a recipient of an e-mail message; and communicating to said sender at least one of said recipient's preferences concerning e-mail received by said recipient, before said e-mail message is transmitted to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). In addition, Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman) hence claimed traits such as the sender specifying recipients are present within Skladman's design. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

7. With regards to claims 8, 11, 18 and 25, Skladman teaches through Lee, the method wherein said preferences concern the size of e-mail messages sent to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). The design allows for notifications to be based on various preferences (column 2, lines 54-65, Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). Actions enforced on emails based on size are a regular email feature. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

8. With regards to claims 9, 12, 19 and 26, Skladman teaches through Lee, the method wherein: said preferences concern rating the importance of said e-mail message, and; wherein said communicating further comprises: providing said preferences as a set of menu entries to said sender; receiving a menu entry selection signal from said sender; and in response to said signal, tagging said e-mail message, to implement said preferences

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). The user is able to select the notification from predefined options. Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an

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improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

9. With regards to claims 10, 17 and 24, Skladman teaches through Lee, a method for providing e-mail services, said method comprising: maintaining a database identifying at least one e-mail recipient and his or her corresponding preferences concerning e-mail received by said recipient; and communicating at least one of said preferences to a sender of an e-mail message, before said e-mail message is transmitted to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). In addition, Skladman's design features a central storage location for the recipient's preferences (notification server, equivalent to the claimed database) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman) hence claimed traits such as the sender specifying recipients are present within Skladman's design. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

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Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

Response to Remarks

The arguments presented in the office action on November 15, 2004 have been carefully evaluated and are deemed persuasive. In response, the examiner has performed a new search and has compiled a new office action. The Skladman prior now being applied features all the elements currently claimed except for the detail regarding the sender setting the flag. In Skladman's design, that sender is the server and it is the server that sets the flag. However, to clarify the examiner's stand on the case, the Lee prior art has been added to illustrate that email designs are present that allow the sender to set the flags to emails before sending them.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

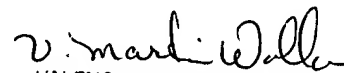
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC


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